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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,283	09/22/2005	Joerg Dehde	3430	1891
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743				
EXAMINER				
MORGAN, EILEEN P				
ART UNIT		PAPER NUMBER		
3723				
MAIL DATE		DELIVERY MODE		
01/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/550,283

**Applicant(s)**

DEHDE, JOERG

**Examiner**

Eileen P. Morgan

**Art Unit**

3723

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) 19-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 19-25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to specific placement of air duct plates along longitudinal direction of tool which is distinct from the original claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-25 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4-11, 15,16,17 rejected under 35 U.S.C. 103(a) as being unpatentable over Kasabian-3,840,762 in view of Kercher-6,224,336.

Kasabian discloses a power tool (20) having a housing (22) with a coolant duct/plate (112) having round openings covering entire plate for a cooling medium to enter and cool motor, the duct consisting of a plate attached to housing (22), wherein at least one element (34) has rounded edges, wherein the openings are located in rows

and columns separated by ribs of equal width. The openings of Kasabian are cylindrical and not conical. However, Kercher teaches cooling an object with a series of coolant holes (54) which are conical (col.4, lines 1-15). The conical shape improves cooling by allowing increased airflow which is more efficient and allows for decreased number of holes needed for proper cooling. Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made to form conical holes in duct of Kasabian in order to increase air flow and more efficiently cool motor. Kasabian does not disclose the exact diameter or depth of the openings. However, it would have been obvious to one of ordinary skill in the art at time invention was made to form the openings within the claimed range of 0.15-10mm<sup>2</sup> since it has been held where the general conditions of a claim are disclosed in the prior art, discovering optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 12, 13, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasabian in view of Kercher, as applied to claims above, in further view of Potter et al.-6,296,427.

Kasabian and Kercher teach the invention as detailed above, but does not show groupings of openings with different diameters (or cross sections). However, Potter teaches a hand powered tool having cooling means comprising openings combined in groups (62,64) having openings of varying cross section. Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made to provide Kasabian with spaced groupings of openings, as shown by Potter, since both

arrangements appear to work equally well for cooling a motor and would be within the level of ordinary skill in the art.

***Response to Arguments***

Applicant's arguments filed 10-22-08 have been fully considered but they are not persuasive. Newly submitted claims 19-25 are directed to a separate and distinct invention and therefore have not been considered. Arguments drawn to these claims are moot.

In response to applicant's argument that Kercher is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kercher, although not using a cooling duct to cool an engine, teaches cooling ducts for cooling turbine engine blade. The teaching is analogous because both inventions focus on improved cooling by using air flow holes. Therefore, the references are analogous and one of ordinary skill would be motivated to look at differently shaped cooling holes to modify the Kasabian reference.

The Affidavit is noted, however, it does not overcome the new rejection. Although Applicant details the advantages of conical holes in his invention, it does not overcome the 103 rejection that includes a teaching reference of using conical holes for

cooling. The reasons and advantages for using conical holes may be different for Applicant but this does not overcome rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P. Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Monday-Thursday, 7am-3:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EM  
January 5, 2009

/Eileen P Morgan/  
Primary Examiner, Art Unit 3723